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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN S. HENDRICKS, ALFRED E. BONNER,
RICHARD E. WUNDERLICH, and ERIC C. BERKOBIN

Appeal 2009-007881
Application 09/396,428
Technology Center 2400

Before: JEFFREY S. SMITH, KALYAN K. DESHPANDE, and BRUCE
R. WINSOR, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE¹

The Appellants seek review under 35 U.S.C. § 134 of a rejection of claims 1, 2, 4-13, and 15-57, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We REVERSE.

The Appellants invented a terminal for use with a program delivery system and providing data storage and retrieval on such a terminal. Specification 1:28 and 2:1-2.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added]:

1. A hardware upgrade for a set top terminal for use with a television program delivery system with menu selection of programs, the set top terminal having a microprocessor and microprocessor instructions for prompting generation of menus, the hardware upgrade comprising:

[1] an interface to the set top terminal for communicating data and video signals between the set top terminal and the hardware upgrade;

[2] a disc storage device connected to the interface providing local storage capacity; and

[3] a microprocessor capable of communicating with the microprocessor of the set top terminal through the interface.

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Feb. 28, 2007) and Reply Brief ("Reply Br.," filed Aug. 29, 2007), and the Examiner's Answer ("Ans.," mailed Jul. 2, 2007), and Final Rejection ("Final Rej.," mailed Jul. 3, 2006).

REFERENCES

The Examiner relies on the following prior art:

Friend	US 4,920,339	Apr. 24, 1990
Graczyk	US 5,192,999	Mar. 9, 1993
Sprague	US 5,247,575	Sep. 21, 1993
Thibadeau	US 5,432,542	Jul. 11, 1995
Granger	US 5,483,277	Jan. 9, 1996
Florin	US 5,583,560	Dec. 10, 1996
Lewis	US 5,638,426	Jun. 10, 1997

REJECTIONS

Claims 1, 2, 4, 6-13, 16-36, 38-44, and 47-55 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, and Graczyk. Ans. 3.

Claims 5, 37, 45, 46, and 56-57 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, Graczyk, Lewis, and Sprague. Ans. 17.

Claim 15 stands rejected under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, Graczyk, and Thibadeau. Ans. 18.

Claims 17-18 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, Graczyk, and Friend. Ans. 19.

ISSUES

The issue of whether the Examiner erred in rejecting claims 1, 2, 4, 6-13, 16-36, 38-44, and 47-55 under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, and Graczyk turns on whether the claimed invention is disclosed in the manner provided by the first paragraph of 35 U.S.C. § 112 in US Patent Application 07/991,074 .

The issue of whether the Examiner erred in rejecting claims 5, 37, 45, 46, and 56-57 under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, Graczyk, Lewis, and Sprague turns on whether the Appellants' arguments in support of independent claims 1, 31, and 41 are found persuasive.

The issue of whether the Examiner erred in rejecting claim 15 stands rejected under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, Graczyk, and Thibadeau turns on whether the Appellants' arguments in support of independent claim 11 are found to be persuasive.

The issue of whether the Examiner erred in rejecting claims 17-18 under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, Graczyk, and Friend turns on whether the Appellants' arguments in support of independent claim 11 are found to be persuasive.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are supported by a preponderance of the evidence.

Facts Related to Appellants' Disclosure

US Patent Application 07/991,074

01. A set top terminal includes a pair of output terminals, a pair of input terminals, a pair of stereo/audio output terminals, a satellite dish input port, a telephone jack, an RS422 port, an upgrade port, and a cover plate. US Patent Application 07/991,074
- Specification 52. A single cable connects an upgrade module and a simple decompression box. A microprocessor in the simple

decompression box communicates with a microprocessor in an upgrade module. Specification 57.

02. A simple decompression box does not have the full functionality of the set top terminal. An upgrade module unit may be connected to a simple decompression box to provide the simple decompression box with the full functionality of a set top terminal. Subscribers who have purchased simple decompression boxes may be given all of the functions of a set top terminal inexpensively. Specification 57.

03. A set top terminal includes a hardware upgrade port. The hardware upgrade port includes at least four-wire connections for (1) data output of the set top terminal, (2) control interface, (3) video output of the set top terminal, and (4) video input port. Specification 54.

04. Hardware upgrades include interactive units for (1) user access to online data base services, (2) high volume local storage capacity, including compact disc or other random access digital formats, (3) digital radio tuner allowing user access to digital radio channels, and (4) user access to download large volumes of information. Specification 54-56.

ANALYSIS

Claims 1, 2, 3, 4, 6-13, 16-36, 38-44, and 47-55 rejected under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, and Graczyk

The claimed invention is the subject of a divisional application of US Patent Application 08/160,194 filed December 2, 1993 (now US 5,990,927), which is a continuation-in-part of US Patent Application 07/991,074 filed on December 9, 1992. App. Br. 14 and Ans. 21-22.

The Examiner found that the Appellants have failed to specifically point out written description and enablement support in US Patent Application 07/991,074 for each limitation in the claimed invention and therefore the claims are not entitled to the benefit of the earlier filing date of December 9, 1992. Ans. 21-23. The Appellants contend that the claims are entitled to the benefit of the earlier filing date because US Patent Application 07/991,074 fully supports the claims. App. Br. 13-15 and Reply Br. 1-3. As such, the Appellants contend that the Examiner has failed to establish a *prima facie* case of obviousness because the Examiner's rejection relies on Florin and Granger to teach or suggest limitations in independent claims 1, 11, 23, 31, and 42 and Florin and Granger are not prior art to the claimed invention. App. Br. 13-15 and Reply Br. 1-3.

We agree with the Appellants.

Limitation [1] of claim 1 requires an interface to the set top terminal to communicate data and video signals between the set top terminal and the hardware upgrade. US Patent Application 07/991,074 describes a set top terminal that includes a pair of input and output ports, including satellite input ports. FF 01. The step top terminal further includes an upgrade port.

FF 01. The upgrade port consists of wire connections for video output/input.

FF 03. As such, US Patent Application 07/991,074 supports limitation [1].

Limitation [2] requires a disc storage device providing local storage capacity that is connected to the interface. US Patent Application 07/991,074 describes the hardware upgrades available for a set top terminal through the hardware upgrade port, or “interface,” include high volume local storage capacity, including compact disc or other random access digital formats. FF 04. As such, US Patent Application 07/991,074 supports limitation [2].

Limitation [3] requires a microprocessor capable of communicating with the microprocessor of the set top terminal through the interface. US Patent Application 07/991,074 describes a microprocessor in the simple decompression box that communicates with a microprocessor in an upgrade module. FF 01. A simple decompression box has less functionality than a set top terminal and can be upgraded through the hardware upgrade port to include this deficient functionality. FF 03.

The Examiner found that a simple decompression box is not a set top terminal. Ans. 22. The Appellants argue that a simple decompression box is a set top terminal with less functionality. App. Br. 14. We agree with the Appellants. As discussed *supra*, US Patent Application 07/991,074 describes a simple decompression as a set top terminal with less functionality and a simple decompression box combined with the hardware upgrade port can include all of the functionality of a set top terminal. That is, a simple decompression box is a subset of set top terminals. Since we find that a simple decompression box is a subset of set top terminals, we find that US Patent Application 07/991,074 satisfies the written description and

enablement requirements of 35 U.S.C. 112, first paragraph with respect to the claimed invention. As such, the claims are entitled to the benefit of the filing date of US Patent Application 07/991,074 because a person with ordinary skill in the art would have understood the Appellants were in possession of the claimed invention.

Since the claims are afforded the filing date of US Patent Application 07/991,074, the Florin and Granger references are not valid prior art. As such, the Examiner has failed to establish a *prima facie* case of obviousness.

Claims 5, 37, 45, 46, and 56-57 rejected under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, Graczyk, Lewis, and Sprague

The Appellants contend that dependent claims 5, 37, 45, 46, and 56-57 depend from independent claims 1, 31, and 41 and Florin and Granger are not valid prior art for the reasons argued in support of claim 1. App. Br. 16. We agree with the Appellants. The Appellants' arguments were found to be persuasive *supra* and are found persuasive here for the same reasons. Since this issue is dispositive as to the rejections against these claims, we need not reach the remaining arguments raised by the Appellants against these rejections.

Claim 15 rejected under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, Graczyk, and Thibadeau

The Appellants contend that dependent claim 15 depends from independent claim 11 and Florin and Granger are not valid prior art for the reasons argued in support of claim 1. App. Br. 16. We agree with the Appellants. The Appellants' arguments were found to be persuasive *supra*

and are found persuasive here for the same reasons. Since this issue is dispositive as to the rejections against this claim, we need not reach the remaining arguments raised by the Appellants against this rejection.

Claims 17-18 rejected under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, Graczyk, and Friend

The Appellants contend that dependent claims 1718 depend from independent claim 11 and Florin and Granger are not valid prior art for the reasons argued in support of claim 1. App. Br. 17. We agree with the Appellants. The Appellants' arguments were found to be persuasive *supra* and are found persuasive here for the same reasons. Since this issue is dispositive as to the rejections against these claims, we need not reach the remaining arguments raised by the Appellants against these rejections.

CONCLUSIONS OF LAW

The Examiner erred in rejecting claims 1, 2, 4, 6-13, 16-36, 38-44, and 47-55 under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, and Graczyk.

The Examiner erred in rejecting 5, 37, 45, 46, and 56-57 under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, Graczyk, Lewis, and Sprague.

The Examiner erred in rejecting claim 15 under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, Graczyk, and Thibadeau.

The Examiner erred in rejecting claims 17-18 under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, Graczyk, and Friend.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1, 2, 4, 6-13, 16-36, 38-44, and 47-55 under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, and Graczyk is not sustained.
- The rejection of claims 5, 37, 45, 46, and 56-57 under 35 U.S.C § 103(a) as being unpatentable over Florin, Granger, Graczyk, Lewis, and Sprague is not sustained.
- The rejection of claim 15 under 35 U.S.C §103(a) as being unpatentable over Florin, Granger, Graczyk, and Thibadeau is not sustained.
- The rejection of claims 17-18 under 35 U.S.C §103(a) as being unpatentable over Florin, Granger, Graczyk, and Friend is not sustained.

REVERSED

msc